

REMARKS

The office action makes a number of observations about the prior art and then makes an obviousness conclusion. Without accepting any of those observations, it is respectfully suggested that the obviousness conclusion is improper. Namely, the obviousness conclusion is based on what the Examiner, with the benefit of hindsight, has considered obvious without any citation to anything in the references themselves to make the modifications claimed.

Take, for example, the requirement that at least a portion of the data accessed during initialization of the system is pinned in the non-volatile cache memory and the requirement that this pinning be performed during initialization of the system. The reference to Green does not pin data access during initialization. Nor does the reference to Bierma. The Examiner concludes on page 3 of the office action that it would be obvious to do what neither of the two cited references do because "additionally, it would have been obvious to one of ordinary skill in the art at the time the invention was made to lock initialization data in the non-volatile cache since this data is always needed by the system and locking it in the cache would make it more readily accessible each time the system has to initialize, thus, speeding up the initialization process." But none of this comes from the prior art. The Federal Circuit case law and Board of Appeal's decisions make it clear that the rationale to modify must come from the prior art, not from the Examiner's imagination.

Therefore, it is respectfully submitted that a *prima facie* rejection is not made out.

Therefore, reconsideration of the rejection is respectfully requested.

Respectfully submitted,

Date: October 21, 2004



Timothy N. Trop, Reg. No. 28,994
TROP, PRUNER & HU, P.C.
8554 Katy Freeway, Ste. 100
Houston, TX 77024
713/468-8880 [Phone]
713/468-8883 [Fax]